

## REMARKS

### Rejection under 35 USC § 102

Claims 1-2, and 5-7 stand rejected under 35 U.S.C. 102(e) as being anticipated by Gershman et al. ("Gershman"). Applicant respectfully traverses.

To anticipate a claim under 35 U.S.C § 102 a single source must contain all of the elements of the claim. Lewmar Marine Inc. v. Barient, Inc., 627 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements "**arranged as in the claim.**" (emphasis added) Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Moreover, "[t]he **identical invention must be shown in as complete detail as is contained in the ... claim.**" (emphasis added) Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q. 1913, 1920 (Fed. Cir. 1989). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. Titanium Metals Corp. v. Banner, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

The claimed invention is directed to a pocket server that enables users at a client computer to collect and organize information for later access through a wireless telephone. The collected information is processed to provide significant user interface leverage, i.e., allowing the user to process such specific information with very little interaction with the mobile device. The leveraging of the display at the mobile device is accomplished by organizing the data, at the pocket server, so it can be presented to the mobile system user as "summarized content" in the form of a card; wherein a collection of cards, defined by a single WML document, is called a deck. In contrast, the Gershman patent describes associating content with a user's requested download without presentation of the associated content in the form of cards and decks for easier navigation with a mobile device.

More specifically, the claimed limitation directed to receiving data from a user "through a base system interface" is not taught by Gershman. The examiner points to the egocentric interface, columns 39-41 of said patent, as a base system interface. Gershman's egocentric interface integrates the content of an intention database, a supplier profile database, and product information database into "content familiar to the individual user." See columns 39-40. The egocentric interface does not provide a boundary across which two systems communicate but merely provides a collection of related matter that might be important to a user. See discussion of Figure 11, column 40, where user centric content is added to a requested web page. Assuming, arguendo, that the egocentric interface is the equivalent of the claimed base system the user does not send data to the base system as claimed because as disclosed in the patent the egocentric database only receives data from other applications and not from the user. See discussion of Figure 10B, column 40, on how data is combined and the origin of such data as used by the egocentric interface. Thus, Gershman is not receiving data from a user as found in the

claimed invention. Since Gershman is not receiving data from the user the steps of storing user data and associating user data is not met.

Another discernable difference is the claimed limitation of presenting or sending the data (summarized) to the mobile system in the form of cards and decks to minimize the display limitations, bandwidth limitations, and general inability of the user to interact with the stored data. In this way the user is able to get the most of the stored data in the reduced navigation environment of mobile systems:

In step 2002, mobile system inter face 210 (Figure 2) builds a hierarchical WML document which is organized as a deck of cards in the manner described above. One card includes all categories of places from which the subject user can chose a desired category. For each of the categories, the deck includes another card representing all subcategories from which the subject user can more particularly specify the desired category. Mobile system interface 210 sends the WML document to wireless telephone 110 for browsing by the subject user. ...The resulting display of the WML document is shown in Figure 21 and shows a number of categories from which the subject user can choose. The categories include: food, fun, travel, and shopping. Of course, other and different categories can be presented to the subject user. Similarly, more or fewer categories can be presented to the subject user. In addition to the listed categories, the WML document includes an option for the subject user to specify a name of a desired place. Page 40, emphasis added.

Because the patent to Gershman does not disclose the claimed limitation of presenting or sending the data in such a way to leverage the display limitations of a mobile system and because the alleged mobile system of Gershman (egocentric interface) does not receive data from a user for storing and associating for later retrieval through a mobile system the rejection under 35 U.S.C. 102(e) should be withdrawn. Claims 1-7 of the application should be allowed in view of the limitation of the cited prior art.

#### Rejection under 35 USC § 103

Claims 3 and 4 stand rejected under 35 U.S.C. 103 as being unpatentable over Gershman et al. ("Gershman"). Applicant respectfully traverses.

Section 2142 of the MPEP explains the examiner's burden of stating a *prima facie* case of obviousness as follows:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. The initial evaluation of *prima facie* obviousness thus relieves both the examiner and applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention. ....To establish a *prima facie* case of obviousness, three basic

criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)

First, the examiner acknowledges that "Gershman does not specifically disclose a second data transport protocol different from the first data transport protocol" as recited in the claimed invention. However, the examiner appears to have taken official notice that "second protocol" as used to "facilitate wireless transmission" is common and well known in the art. To the extent the examiner was taken official notice, applicants respectfully hereby seasonably challenge such official notice and respectfully request an affidavit or citation to prior art providing such a teaching as required by 37 CFR 1.104(d) (2) and MPEP § 2144.03. As noted by the Federal Circuit, deficiencies of the cited references cannot be remedied by the examiner's general "conclusions about what is 'basic knowledge' or 'common sense.'" In re Sang Su Lee, 61 USPQ2d 1430 at 1434-35 (quoting In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)) (citation omitted). The examiner's assertion that "a second and different protocol such as a wireless application protocol would be used to facilitate wireless telephone and PDA data transmission" is too general and can apply to many cases. However, in the method used in the present invention, the user supplies data through a first data transport protocol and accesses the data through a second data transport protocol. Absent some showing that such was known to those of skill in the art at the time the invention was made, applicants respectfully submit that such is novel and non-obvious and therefore allowable over the cited art.

Second, the examiner has failed to state any motivation to combine Gershman to meet applicant's claimed limitations, much less point to any such motivation in the prior art. Rather, the examiner has simply made a rejection of the form "Gershman teaches Y; therefore it would have been obvious that a 'wireless application protocol would be used to facilitate wireless telephone and PDA data transmission.'" (See Office Action, page 6). As the Federal Circuit decision in In re Sang Su Lee (supra) makes clear, each and every element of the applicants' claims must be supported by a prior art citation in order to reject the applicants' claims. Such a statement by the examiner that "it would have been obvious to include a wireless protocol as a second and different protocol.", Office Action at page 6, is not supported by the prior art in view of the novel features of the invention.

#### Documents Cited but Not Relied upon for this Office Action

The Smethers patent cited (6,560,640) but not relied upon for this Office Action has been considered. The cited reference does not affect the patentability of the present claims because the Smethers patent does not disclose or suggest, singularly or in combination with the art of record, the claimed action of associating user supplied data with the user. This association allows the collected data to be organized in such way to

make navigating easier and more user efficient. The Smethers patent in its most relevant sections is to a technique of mapping bookmarks residing at a proxy server to keys of a mobile device to reduce navigating actions and conserve memory resources at the mobile device.

### CONCLUSION

Applicant believes this reply is fully responsible to all outstanding issues and places the application in condition for allowance. If this belief is incorrect, or other issues arise, the examiner is encouraged to contact the undersigned at the telephone number listed below.

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Respectfully submitted,

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